

ARGUMENTS/REMARKS

Applicants would like to thank the examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 1-12 remain in this application. Claim 12 has been withdrawn as the result of an earlier restriction requirement, and applicant retains the right to present that claim in a divisional application. New claims 13-20 are added without adding any new matter.

Claims 1-4 and 9-11 were rejected under 35 U.S.C. §102(b) as being anticipated by Shuto *et al.* (U.S. 6,471,816). Claims 5-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Shuto in view of Nagao *et al.* (U.S. 6,670,541). For the following reasons, the rejections are respectfully traversed.

First, claim 1 has been amended to clarify various features that are not found in the cited reference. For example, claim 1 recites that the power generating product includes “a sealing material applied at an outer side of the base plate, wherein said electric conductor is provided through said sealing material to said contact portion”, which is not found in Shuto. Instead, Shuto teaches that the openings 28 are completely filled with a conductive material 52, and that the conductor lead wire is connected to this conductive material (see col. 8, lines 37-42). Even in the section cited by the Examiner, the teaching is only that a lead wire 30 is soldered to the back side of the metal foil 22, referring to Fig. 6. That figure does not show the lead wire 30 being provided through the solder, and in fact, such is not necessary because solder is conductive. The figure clearly shows that the lead wire 20 is attached to the solder, without any suggestion that the wire is provided to the foil 22 through the solder. Thus, claim 1 is patentable over the reference for this reason.

In addition, claim 1 recites that the blind hole has “lateral sides” that are even and a “bottom having an uneven surface at said contact portion”. Nothing in the reference

teaches any uneven bottom surface at the contact portion, and thus claim 1 is patentable over the reference for this reason as well.

Furthermore, the Examiner erroneously gives no patentable weight to the limitation that “said blind hole is a hole perforated through said base plate after the lamination of said power generating film over said base plate”. The MPEP makes clear that a “product by process” limitation is not to be ignored. Instead, the structure implied by the process steps should be considered (see MPEP §2113). The Examiner has failed to consider such implied structure, and instead has improperly ignored the claim limitation entirely. Instead, the Examiner must show that the implied structures are also found in the prior art.

Thus, for any of the above reasons, claim 1 is patentable over Shuto. New claim 17, which has at least some limitations similar to some of those discussed above, is also patentable over Shuto. The remaining claims, which depend on one of claims 1 or 17, are patentable over the reference for at least the same reasons as their parent claims. Because Nagao does not overcome the Shuto shortcomings, the claims are also patentable over the combination of references.

Further, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a *prima facie* case of obviousness (MPEP §2142). To support a *prima facie* case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish *prima facie* obviousness (*Id.*). The prior art must also suggest the desirability of the combination (*Id.*). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish *prima facie* obviousness (*Id.*).

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be

produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

“To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at that time to that person.” (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious “as a whole”, not as a piecemeal combination of elements from various references.

The advantage cited by the Examiner is general and does not lead one skilled in the art to make the particular modification suggested by the Examiner. Accordingly, the rejection for obviousness is not supported by the Office action and is instead improper hindsight motivation, and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 36202.

Respectfully submitted,
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